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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/025,027  | 12/19/2001  | Michael Tod Morman   | KCC-16,088          | 5892             |
| 35844   | 7590        | 03/21/2006           | EXAMINER            |                  |
| PAULEY PETERSEN & ERICKSON<br>2800 WEST HIGGINS ROAD<br>HOFFMAN ESTATES, IL 60195 |             |                      | REICHLER, KARIN M   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3761                |                  |

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/025,027 | <b>Applicant(s)</b><br>MORMAN ET AL. |  |
|                              | <b>Examiner</b><br>Karin M. Reichle  | <b>Art Unit</b><br>3761              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 2,5 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7 and 11-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/2/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/2/06 has been entered.

### *Election/Restrictions*

2. Claims 2, 5 and 8-10 are still withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 2-12-2004.

### *Specification*

3. The following action is based on the abstract filed 5-16-05, the amendments to the specification filed 8-11-05 and the claims and remarks filed 2-2-06.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: At the very least, see discussion in the following paragraphs, antecedent basis for “an insubstantial amount” should be set forth.

5. The disclosure is objected to because of the following informalities: At the very least, see also the discussion in paragraphs 4 and 6, the range of necking tension applied as set forth by the language “from above an insubstantial amount to about 80%” is unclear, i.e. what specific value defines the lower end point of the range called “an insubstantial amount”? For example, is the range just greater than 0% to about 80%? Just less than “at least about 5% to about 80%”? Just less than about 10% to about 80%? Just less than about 20% to 80%? Just less than about 30% to about 80%? Specifically, the independent claims now require application of a necking tension from above an insubstantial amount to about 80%. New claims 26-33, each of which directly depend from one of the independent claims, sets the lower point of such range at “at least about 5%”, “from about 10 %”, “from about 20%” or “from about 30%”. The originally filed specification at, e.g., page 10, first full paragraph and page 22, line 15-page 23, line 2 describes the necked web as capable of being necked up to about 80 percent (about 20 percent of its original width), i.e. necking tension is applied to neck up to about 80 percent, i.e. more than 0% to about 80%. The originally filed specification also further describes specific narrower ranges within such range similar to those set forth in claims 27-29 and 31-33 as being desired or more desired. In other words, the value of “an insubstantial amount” in light of the original specification might be interpreted as 0%. However, nowhere in the specification is such a specific 0% numeric value described as the value of “an insubstantial amount”, see paragraph 4 *supra*. The lack of clarity is further exacerbated by the new dependent claims which set a lower end point of such range which might also inherently define, i.e. since proper dependent claims further limit the invention of the claim from which it depends, the value of “an insubstantial amount” to be at least less than such lowest range value in claims 26-27 and 30-31 or at least the

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same as such lower range value in claims 28-29 and 32-33. (Attention is also invited to Applicant's remarks at page 11, second full paragraph, i.e. appears to set forth that the range set forth by the original specification, i.e. more than 0% up to 80%, includes percentages of necking which are so little as to be without practical effect, i.e. "an insubstantial amount" requires a percentage of necking which applies "more than an incidental effect". See discussion of such remarks in the Response to Arguments section supra). A clear, consistent description of the claimed ranges of necking percentages, i.e. the value of "an insubstantial amount", which is supported by the original disclosure should be set forth. See Claim Language Interpretation section infra.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

6. Claims 1, 3-4, 6-7, and 11-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3-4 and 6, are one or both of the web layers and the web as set forth in claim 1 one and the same, i.e. how many webs at a minimum are required by claims 3-4 and 6? This also applies to the first material claimed in claims 16 and 21 and the web as set forth in claim 1 and the second material claimed in claims 16 and 21 and the elastic material as set forth in claim 1. While Applicant's remarks on page 10 have been considered, the claim language has not been amended to reflect such remarks. Furthermore, see also discussion set forth in paragraphs 4 and 5, the range of necking tension applied as set forth by the language "from above an insubstantial

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amount to about 80%” is unclear, i.e. just greater than 0% to about 80%? Just less than “at least about 5% to about 80%”? Just less than about 10% to about 80%? Just less than about 20% to 80%? Just less than about 30% to about 80%? See Claim Language Interpretation section infra.

### ***Double Patenting***

7. Applicant is advised that should claim 7 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicant's remarks have been reviewed but are deemed not persuasive because the specific time element is inherent in claim 16. If Applicant maintains such argument, Applicant is requested to present an example where the structure claimed in claim 16 would result which does not require the time element of claim 7.

### ***Claim Language Interpretation***

8. Due to the lack of clarity discussed supra, the specification and the Applicant's remarks, “a web of precursor garments” as set forth in claims 1, and 13-15 will be interpreted as at least one layer which is be used in the making of a garment. This web will be considered to be the backsheet web layer at a minimum in claims 3 and 6, either such layer or the topsheet at a minimum in claim 4, and the first material in claims 16-25. The elastic material in claim 1 will be considered to be the second material at a minimum in claims 16-25. The claim language is

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also interpreted in light of the definitions at page 9, lines 4-10, page 9, line 20-page 10, line 3, page 10, line 21-page 11, line 8, and page 11, lines 12 et seq. Therefore, “an insubstantial amount” as set forth in the claims is interpreted to be 0%, as best understood, see discussion *supra*. It is also noted that exact dimensions of the first and second widths nor the exact difference between the latter has been set forth, i.e. the tension and necking could be such that the second width could be just larger than the first width. It is further noted that the second width is not required to be exactly the same as the original width.

***Claim Rejections - 35 USC § 102/103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1, 3, 4, 6-7, and 11-25 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Litchholt '027.

See Figures 1-3 and 5, Claim Language Interpretation section *supra*, col. 4, lines 43-46, col. 15, lines 57-65, col. 16, lines 10-12, col. 7, lines 4-12, col. 18, lines 6-10, and 16-28, col. 18, line 66-col. 19, line 2, col. 19, lines 17-21, col. 20, lines 44-51 and 26-33, col. 21, lines 27-55, col. 25, lines 19-40, col. 26, lines 13-17 and 28-63, col. 27, lines 30-51, col. 28, lines 22-23, col. 29, lines 3-5, 50-56 and col. 32, lines 31-43, i.e. Litchholt teaches a method of producing elastic cuffs, i.e. waist and/or leg, for a resultant garment, i.e. diaper, obtained from a web, i.e. a topsheet and/or backsheet, of precursor garments which method includes the steps of applying tension sufficient to prestrain or prestretch, e.g. distort, the web of precursor garments, i.e. at least a portion thereof, to prestrain or prestretch, e.g. distort, a cuff area of a precursor garment

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to a first dimension, the cuff area of the precursor garment being extendible, i.e. having the capability to extend, when the tension is removed, affixing an elastic material to the cuff area while at the first dimension, i.e. while tensioned, removing the tension from the precursor garment web with the elastic material thereon and the elastic material holding the cuff area at a dimension in the resultant garment. It is the Examiner's first position that the Litchholt reference explicitly teaches necking to a first dimension by the tensioning, the web capability of extensibility to a second greater non-necked dimension and causing the web to assume such second dimension at areas outside the cuff area having the elastic material thereon upon removal of the tensioning, and holding of the selected area of the web by the elastic material at a dimension narrower than the second dimension at the cuff area because, e.g., Litchholt teaches tensioning at least a drawable nonwoven (It is noted that such could be at most elastomeric) to a "distorted configuration", i.e. a necked configuration, using the tension rollers and combining rollers, then completely attaching an untensioned elastic to at least cuff forming portions of such nonwoven and the nonwoven material itself not having, at the very least, the capability to fully return to its original configuration after tensioning, e.g. can return to just less than its original configuration, at the cited portions above. In any case, the Examiner's second position, since the Litchholt reference provides such teachings, i.e. the same steps performed using the same materials as claimed, note the definitions in the specification set forth in the Claim Language Interpretation section *supra*, there is sufficient factual basis for one to conclude that the selected area of the material is necked and held by the unstretched elastic material at the necked dimension at which the elastic was attached rather than retract, i.e. expand, towards its original undistorted dimension when the tensioning is removed while the areas of the web not underlying



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and attached to the elastic material, i.e. only the material, will retract, i.e. expand, towards its relaxed original undistorted dimension, i.e. a greater non-necked second dimension, when the tensioning is removed, i.e. such is inherent in the method taught by Litchholt. See MPEP 2112. Finally, the Examiner's third position, since Litchholt at the very least teaches tensioning at least a drawable nonwoven (It is noted that such could be at most elastomeric) to a "distorted configuration" using the tension rollers and combining rollers, then completely attaching an untensioned elastic to at least cuff forming portions of such nonwoven and the nonwoven material itself not having, at the very least, the capability to full return to its original configuration after tensioning, e.g. can return to just less than its original configuration, at the cited portions above, it would be obvious to one of ordinary skill in the art that the Litchholt method necessarily and inevitably includes the claimed steps, i.e. necking a first dimension, i.e. a distorted configuration, by the tensioning, the web having the capability of extensibility to a second greater non-necked dimension and causing the web to assume such second dimension at areas outside the cuff area having the elastic material thereon, i.e. completely bonded thereon, upon removal of the tensioning, and holding of the selected area of the web by the elastic material at a dimension narrower than the second dimension at the cuff area, especially in light of the teachings of '027 at, e.g. col. 19, lines 30-58, and thereby Buell '793 at, e.g., col. 5, lines 15-27, col. 12, lines 9-15 and 35-43, col. 16, lines 22-37 and col. 2, lines 49-59, i.e. lack of puckering and bunching and lack of z-direction bulking due to tensioning and bonding.

With regard to claims 19-20 and 24-25, see col. 32, line 40.

***Claim Rejections - 35 USC § 103***

11. Claims 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litchholt '027. See Claim Language Interpretation Section supra. These claims claim narrower ranges than that in claims 1 and 13. It is noted that the criticality of such ranges as compared to the wider range has not been disclosed, i.e. only set forth as desirable. It is further noted that Litchholt, see rejection supra, contemplates tensioning and a value within the claimed range and disclosed range, i.e. more than 0%, as best understood. Also as set forth by '027 at, e.g., col. 19, lines 30-58, and thereby Buell '793 at, e.g., col. 5, lines 15-27, col. 12, lines 9-15 and 35-43, col. 16, lines 22-37 and col. 2, lines 49-59, i.e. lack of puckering and bunching and the lack of z-direction bulking due to tensioning and bonding is recognized by '027. Therefore, the general conditions of the claims are taught by the prior art at least. Furthermore, where, as here, the general conditions of the claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, see *In re Aller*, 105 USPQ 233. See also response to Arguments section infra.

***Response to Arguments***

12. Applicant's remarks with regard to the informalities on page 9, line 1-page 11, line 3 have been noted but are either deemed moot in that they have not been reraised or are deemed not persuasive for the reasons set forth supra. Applicant's request for an interview is noted. However in light of the new grounds of rejection and other new issues, such request is held in abeyance until review of this action by the Applicant. Furthermore, in order to more readily identify such a request in a timely manner, Applicant is requested to personally contact the

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Examiner with any further requests for an interview. Applicant's remarks with respect to the claim language on page 11, second full paragraph have been noted. Since the Examiner's position in the last Office Action in the Claim Language Interpretation section was that the percentage necking required by the claims could be just greater than 0% up to 80%, it appears Applicant is arguing that the amount of tensioning or necking just greater than 0% to some "insubstantial amount" is so little as to be without practical effect. Yet this amount was set forth as being contemplated as having such practical effect in the original specification, see portions thereof cited in paragraph 5, supra. Therefore, it appears that such argument introduces new matter because it disclaims a part of the range originally disclosed as being critical as no longer being so, i.e. being without practical effect, i.e. since the specification does not set forth that the claimed range has its own criticality apart from the criticality of the range disclosed, such argument appears to introduce new matter because the range of more than 0% up to "an insubstantial amount" which was previously considered necessary for criticality before the amendment is no longer deemed necessary for criticality. Finally, as set forth supra, what value is being given to "an insubstantial amount is unclear. It certainly has not been disclosed as the amount coinciding with "more than an incidental effect to achieve the desired functionality" as argued.

Applicant's arguments on pages 11-15 have also been considered but are deemed not persuasive not only for the reasons set forth in the immediately preceding discussion with respect to claim language scope but also because such are narrower than the teachings of the prior art, see the cited portions of '027 and '793 supra, as well as '793 at the sentence bridging cols. 12-13, col. 13, lines 62-62 and col. 16, lines 42-47. Specifically, "zero strain laminates" do not

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require the lack of tension. With regard to claims 7, 16 and 21, '027 and '793 teach the lack of puckering and negligible z-direction expansion embodiments. Figures 3 and 4 of '027 illustrate only one of the disclosed embodiments, i.e. a non-continuously bonded laminate embodiment, i.e. non-complete attachment, not the continuously bonded laminate embodiment. With respect to claims 19-20 and 24-25, the citation argued by Applicant is not limited to the foam.

### *Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
March 9, 2006